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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,287	11/03/2003	Rodney Carl Harris	10016459-1	4508

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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WILLS, LAWRENCE E

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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05/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM  
mkraft@hp.com  
ipa.mail@hp.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/700,287	<b>Applicant(s)</b> HARRIS ET AL.	
	<b>Examiner</b> LAWRENCE E. WILLS	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-9,11,12,14-22,24,25,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-9, 11,12, 14-22, 24-25,40-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 7, 8, 11, 12, 17, 18, 19, 20, 21, 24, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 7,295,339) in view of Iggulden (US Patent 4,918,723).

Regarding claim 1, 17, and 40, Kobayashi'339 teaches a system for enabling electronic document ratification, the system comprising: a sending device configured to transmit an

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electronic document (electronic mail communication, column 12, line 40-42) ; and a printing device configured to receive the electronic document transmitted by the sending device (number 26, Fig. 1, in addition, notice applied to printer, column 12, line 40-42), and to add the handwritten content to the electronic document without replacing original content of the electronic document (S6, Fig. 4). Kobayashi'339 fails to teach to print the electronic document to provide a recipient with a hard copy of the document upon which the recipient can write; to scan handwritten content manually handwritten on the hard copy by the recipient.

Iggulden'723 teaches to print the electronic document to provide a recipient with a hard copy of the document upon which the recipient can write; to scan handwritten content manually handwritten on the hard copy by the recipient (notice printed sheet with manual handwriting being scanned by scanner 64, Fig. 11).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 3, the combination of Kobayashi'339 and Iggulden'723 teach wherein receiving an electronic document comprises the printing device receiving a PDF file (Kobayashi'339 column 12, line 40-42).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 7, the combination of Kobayashi'339 and Iggulden'723 teach wherein scanning handwritten content comprises the printing device only scanning the manually handwritten content (Iggulden'723 number 62 and number 64, Fig. 11).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 8 and 21, the combination of Kobayashi'339 and Iggulden'723 teach wherein only scanning the manually handwritten content comprises the printing device only scanning handwritten content contained within an input block of the document (Iggulden'723 number 62 and number 64, Fig. 11).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 11, 24, and 41, the combination of Kobayashi'339 and Iggulden'723 teach wherein adding the handwritten content comprises the printing device adding the handwritten content within an input block of the electronic document (Kobayashi'339, S5 and S6, Fig. 4).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 12, the combination of Kobayashi'339 and Iggulden'723 teach further comprising at least one of the printing device reprinting the electronic document after the handwritten content has been added, transmitting the electronic document after the handwritten content has been added, and storing the electronic document after the handwritten content has been added (Kobayashi'339 S8, Fig. 4).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 18, the combination of Kobayashi'339 and Iggulden'723 teach wherein the printing device comprises at least one of a digital sender and a multi-function peripheral (MFP) device (Kobayashi'339 column 11, 55-60).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 19, the combination of Kobayashi'339 and Iggulden'723 teach wherein the printing device comprises a multi-function peripheral (MFP) device configured to print, copy, scan, and transmit documents (Kobayashi'339 column 11, 55-60).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 20, the combination of Kobayashi'339 and Iggulden'723 teach wherein the printing device comprises a document scanner (Kobayashi'339 numbers 24,25, Fig. 1).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

5. Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 7,295,339) in view of Iggulden (US Patent 4,918,723) as applied to claim 1 and 20 above, and further in view of Adobe Acrobat 4.0 User Guide.

Regarding claim 9 and 22, the combination of Kobayashi'339 and Iggulden'723 fails to teach wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received electronic document to identify the handwritten content was added by the recipient.

Adobe teaches wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received electronic document to identify the handwritten content was added by the recipient (document compare, page 3).

Having a system of Kobayashi'339 and Iggulden'723 reference and then given the well-established teaching of Adobe reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 and Iggulden'723 reference to include document compare as taught by Adobe reference, since doing so would increase the versatility of the signed-document creation system.



6. Claims 14-16, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 7,295,339) in view of Iggulden (US Patent 4,918,723) as applied to claim 1 and 17 above, and further in view of Brown (US Patent 6,671,805).

Regarding claim 14, the combination of Kobayashi'339 and Iggulden'723 fails to teach the sending device identifying an input block of the electronic document prior to transmitting the electronic document to the printing device.

Brown'805 teaches the sending device identifying an input block of the electronic document prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 and Iggulden'723 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 and Iggulden'723 reference to include document compare as taught by Brown'805 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 15, the combination of Kobayashi'339 and Iggulden'723 fails to teach further comprising the sending device adding metadata to the electronic document that identifies that the electronic document is to be ratified prior to transmitting the electronic document to the printing device.

Brown'805 teaches the sending device adding metadata to the electronic document that identifies that the electronic document is to be ratified prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 and Iggulden'723 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 and Iggulden'723 reference to include document compare as taught by Brown'805 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 16, the combination of Kobayashi'339 and Iggulden'723 fails to teach further comprising the sending device adding metadata to the electronic document that identifies a location of an input block of the electronic document prior to transmitting the electronic document to the printing device.

Brown'805 teaches comprising the sending device adding metadata to the electronic document that identifies a location of an input block of the electronic document prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 and Iggulden'723 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 and Iggulden'723 reference to include document compare as

taught by Brown'805 reference, since doing so would increase the versatility of the signed-document creation system.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

LEW  
May 12, 2008